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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,642	03/23/2004	Henry P. Anderson III	51490/VGG/P690	5329
23363	7590	05/05/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			LOCKER, HOWARD J	
		ART UNIT		PAPER NUMBER
		1661		
DATE MAILED: 05/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/807642	Anderson, et al.
Examiner	Group Art Unit	
Howard J. Locker	1661	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

Responsive to communication(s) filed on 3/23/04 and 6/21/04.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

Claim(s): The claim is ~~is~~ pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s): The claim is ~~is~~ rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

Information Disclosure Statement(s), PTO-144, Paper No(s). 062104  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

1. The following is a quotation of section (a) of 37 CFR 1.163:

"(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered."

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor in carrying out his invention."

In plant applications filed under 36 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

"No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known varieties and antecedents.

A. Given that the stated parentage of the instant cultivar is unknown, additional information should be imported into the specification as to the location and area where the instant cultivar was found. Additionally, unless the instant plant is indeed a newly discovered plant or the result of planting of mixed seed of unknown origin, it would seem that at least the maternal parent would be known with some certitude.

B. To the extent that additional information relative to "A" above is known and is imported into the instant specification, it may be necessary for applicant to amend the Genus/species designation so as to be more descriptive. In any event, it would appear that the proper and recognized Genus designation should read *Pistacia* (see attached Huxley et al. excerpt).

C. While the specification makes mention of the instant cultivar's "particular usefulness as a rootstock upon which commercial nut bearing pistachio varieties may be budded or grafted", no corresponding features (dwarfing capacity, disease

resistance, increased vigor, increased propensity to self-root, drought resistance, etc.) to lend substance to same are set forth or described in the specification. Indeed, it is questionable whether the instant cultivar, as presently described and illustrated, distinguishes over the species *per se* (see, for example the attached Huxley et al. excerpt). Additional information should be imported into the specification so as to more fully and completely address this issue.

D. Relative to asexual propagation of the plant, and its intended use as a rootstock, it is interesting to note that the plant itself is stated to be asexually propagated by budding onto *P. integerrima*. As such, it would appear that *P. integerrima* is the rootstock, rather than the instant cultivar. Correction and/or clarification is necessary relative to this issue.

E. Relative to the description of the new variety as set forth at page 3 and on of the specification, the age of the plants described is questioned, inasmuch as trunk diameter of 1.58 inches at 12 inches above soil surface seems small for a three year old plant. Correction and/or clarification is necessary.

F. Information should be imported into the specification relative to characteristic and observed plant height and spread at the stated age and location of culture.

G. Date or year of initial plant discovery should be set forth in the specification.

H. If the plant has been grown for a sufficient length of time and maturity that flowers/fruit have been observed, the botanical description should be expanded so as to include a systematic description of same, as absent disclosure to the contrary, such

would appear to be the characteristic and inevitable expression of the plant, notwithstanding the intended use of the plant as a rootstock.

I. The specification should be expanded to account for other characteristic and observed plant characteristics, such as hardiness, disease resistance, etc.

Applicant should carefully review the instant disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant, for the reasons advanced in paragraph 1 above.

3. The references cited by applicant have been considered and have been made of record (see attached PTO/SB08A/B, substitute for PTO-1449 A/B). United States Plant Patent Numbers 10274 and 10275 are cited to show the state of the art, and copies of same are included with this Office action.

4. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/ola/preognitice/moreinfoamprac.htm>

5. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

### **TELECOPY/FACSIMILE TRANSMISSION**

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306. The new central fax number for official correspondence is 571-273-8300.

Howard J. Locker/hjl  
April 04, 2005

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661